

REMARKS

Applicants believe that the following comments overcome the rejections set forth in the July 15, 2003 Office Action and that the rejections therein should be
5 withdrawn.

I. THE INVENTION

Generally, the present invention is a system for accessing electronic data via a familiar printed medium.
10 Specifically, the familiar printed medium is a printed catalog having at least one machine recognizable feature, which may be one of various embodiments including, but not limited to, a watermark, bar code, invisible bar code, magnetic code, printed character, invisible icon, etc. In
15 the present invention, these machine recognizable features are scanned or sensed and converted into an electronic signal, which is transmitted to be processed. The processing results in the display of programming material related to the information contained in the printed
20 catalog. Importantly, the present invention is designed to allow a user to access programming material related to the information contained in the catalog to supplement the information provided by the printed catalog.

II. THE EXAMINER'S REJECTIONS

The Examiner rejected claims 262-362 under 35 U.S.C. § 103(a) as being unpatentable over Gupta U.S. Pat. No. 5,382,779 ("Gupta") in view of Schlafly U.S. Pat. No. 4,734,858 ("Schlafly") and the "general teachings of the prior art of record" (July 15, 2003 Office Action, p. 3).

The Examiner argued that:

10 "Gupta discloses a shelf price label verification apparatus and method. According to Gupta, the scan routine (43) is started when the employee takes the verification unit out into the store to begin scanning. The employee scans a shelf-price label (44) pressing the trigger
15 switch (16) on the wand (15) or gun. This causes the scanning means to read the label, and the UPC (22) and price (23) from the label are decoded by the CPU and loaded into the RAM (37). The CPU then uses the UPC as a key to look up (retrieve)
20 an item record (45) in the database on the disk (35)....

25 According to Gupta, it is not necessary for the data base to reside in the verification unit, though this is preferred. If desired, the 'disk' in the verification unit can be eliminated, and the 'I/O' link (34) in FIG. 3 between the verification unit (30) and the store computer (60) would become a remote link, using whatever
30 radio (RF) or infrared (IR) technology is current at the time." (*Id.* at pp. 3-4)

Given this functionality, the Examiner concluded that
"Gupta discloses the means and method for scanning,
35 transmitting and retrieving information from a machine

recognizable bar code." (*Id.* at p. 4) The Examiner appreciated, however, that Gupta does not disclose a machine recognizable feature printed in a catalog. That, the Examiner argued, is disclosed by Schlafly:

5 "Reference to Schlafly is cited as evidence
showing the step of scanning a product code such
as a bar code 158 from a catalog 82 for a product
ordering system. Specifically, figures 4-5 of
10 Schlafly shows [sic] the catalogs containing the
bar codes. Schlafly system [sic] includes a
light pen, a transmitter 152, a display 68, a
processor 130, a keyboard 66, and a memory 132.
It would have been obvious to incorporate the
step of scanning a product code from a catalog in
15 the system as taught by Gupta." (*Id.*)

Thus, the Examiner concluded that the combination of Gupta and Schlafly teach the present invention because such a combination "allows the user to perform [a] price check
20 for the product that is printed in the catalog and compares
[it] with the price obtained from the products on the
shelves." (*Id.* at pp. 4-5)

The Examiner further stated that interchanging various forms of codes "such as a watermark, an invisible barcode,
25 a magnetic code, a printer character, a invisible [sic]
icon, etc." is "notoriously well known and old." (*Id.* at
p. 5) In that regard, the Examiner cited to Konishi U.S.
Pat. No. 5,237,156 ("Konishi") and Younger U.S. Pat. No.
5,151,687 ("Younger") for support.

III. THE EXAMINER'S REJECTIONS SHOULD BE WITHDRAWN

The Examiner rejected all pending claims 262-362 under 35 U.S.C. § 103(a) as being unpatentable over Gupta in view of Schlafly and the "general teachings of the prior art of record." (*Id.* at p. 3)

Applicants respectfully submit that none of the aforementioned claims are obvious in view of Gupta, Schlafly, and the general teachings of the prior art. In order for a claimed invention to be obvious in view of a combination of references, three criteria must be met: 1) there must exist a suggestion or motivation to modify the reference or to combine reference teachings; 2) there must be a reasonable expectation of success; and 3) the prior art references, when combined, must teach or suggest all of the claim limitations. (see *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)) (see also Manual of Patent Examining Procedure §§ 2143-2143.03).

Initially, Applicants submit that no suggestion or motivation exists to modify Gupta or combine it with Schlafly and any of the teachings of the prior art of record. Standing on their own, these references provide no justification for the combination asserted by the Examiner.

“Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.” ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984) (emphasis in original).

The Examiner contends that it would be obvious to combine the teachings of Gupta with Schlafly and the general teachings of the prior art of record to arrive at the various embodiments of Applicants’ invention. Applicants submit that none of these combinations would have been obvious to one skilled in the art at the time of Applicants’ invention.

First, no suggestion or motivation exists for adding the catalog ordering system disclosed in Schlafly to Gupta. Gupta teaches a simple price verification system that is used by retail employees to ensure that products on a shelf are priced correctly. Initially, the system scans a label comprising a UPC and a price code. Next, the system uses the UPC to look up the stored price in a database. Finally, the system compares the labeled price to the stored price and reports any inconsistency. In contradistinction, Schlafly is system used by consumers to purchase products via a catalog. The system is capable of

scanning a barcode that represents the product and later transmitting the scanned information to a processing center where the customer's order is filled. These two systems are directed to entirely different users and teach very different functionality. Whereas a motivation may exist to combine other methods of price verification with Gupta, a barcode-based catalog ordering system cannot provide that function, and therefore, there is no motivation or suggestion to combine Schlafly or any other barcode-based ordering system with Gupta.

Furthermore, there is absolutely no incentive to combine Gupta and Schlafly in the particular fashion suggested by the Examiner. The Examiner suggests that combined, these two references will yield a system that will allow the user to "perform [a] price check for the product that is printed in the catalog and compare[] [it] with the price obtained from the products on the shelves." (July 15, 2003 Office Action at pp. 4-5) However, such a system negates the functionality of Gupta. The novelty of Gupta lies in its ability to scan a product and price code and electronically compare it to a stored price for verification. The system suggested by the Examiner involves scanning a product and comparing the scanned price

with one that is printed in a catalog. Such a combination is a far step back for the art, and thus is not apparent given the automation suggested by both Gupta and Schlafly. In fact, Gupta explicitly teaches against such a
5 combination:

10 "Having an employee manually check every shelf price against a price list will eliminate some of the [efficiency] gains made by going to shelf pricing in the first place." (Gupta, col. 2, lines 48-50)

Hence, not only do the references not suggest the combination urged by the Examiner, they discourage it. Furthermore, given that the combination of Gupta and
15 Schlafly is improper, all subsequent rejections relying on this combination are also improper. For example, the Examiner apparently relies on the combination of Gupta, Schlafly, and Konishi to reject claim 352. Although Konishi does mention the use of "magnetic characters," they
20 are used in a completely unrelated photograph cataloging system. In short, the Examiner is combining two references in a way discouraged by Gupta, and to that combination is adding a feature of a device from a wholly unrelated field of art. Clearly, such a combination is improper.

25 Upon reconsideration, the Examiner will undoubtedly recognize that the reasons put forth for the § 103(a)

rejection actually support an "obvious to try" conclusion. Of course, "obvious to try is not the standard for obviousness under 35 U.S.C. § 103." Hybritech, Inc. v. Monoclonal Antibodies, Inc., 231 U.S.P.Q. 81, 91 (Fed. Cir. 5 1986).

Under these circumstances, we respectfully submit that the Examiner has succumbed to the "strong temptation to rely on hindsight." Orthopedic Equipment Co. v. United States, 702 F. 2d 1005, 1012, 217, U.S.P.Q. 193, 199 (Fed. 10 Cir. 1983):

It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claim in suit. 15 Monday morning quarterbacking is quite improper when resolving the question of nonobviousness in a court of law.

Applicants submit that the only suggestion or 20 motivation for the Examiner's combination of references is provided by the teachings of Applicants' disclosure. No such suggestion or motivation is provided by the references themselves; nor could there be in view of the difference in subject matter and the goals of the present invention.

25 In addition to the lack of suggestion or motivation to combine any of the aforementioned references, there is no expectation of success in the aforementioned combinations.

Gupta provides a price verification system that allows retail employees to verify shelf pricing. In contrast, Schlafly teaches a barcode-based catalog ordering system. Combining, as the Examiner suggests, the catalog of Schlafly with the price verification system of Gupta does not yield a system approaching the present invention. Indeed, the Examiner suggests that this combination results in a system that allows a user to manually compare prices in a catalog to prices on a shelf. (See July 15, 2003 Office Action at pp. 4-5) Such a system is antiquated and labor-intensive even compared to Gupta and Schlafly, let alone the present invention. Having a human check prices by manually comparing one price to another and does not approach the novelty of the present invention. Thus, one skilled in the art performing such a manual process has no reasonable expectation of successfully arriving at the present invention.

Consequently, Applicants submit that all pending claims of the present invention are not obvious in view of the cited references because there is no suggestion or motivation to combine the references and any attempted combination of these references does not have a reasonable expectation of success.

CONCLUSION

Applicants submit that all pending claims represent a patentable contribution to the art and are in condition for allowance. No new matter has been added. Early and
5 favorable action is accordingly solicited.

Respectfully submitted,

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